REMARKS

By this amendment, no claims have been cancelled. Claims 38-41 and 74-77 have been amended. New Claims 92-95 have been added. Hence, Claims 27-52, 63-88, and 92-95 are pending in the application.

SUPPORT FOR AMENDED CLAIMS AND NEW CLAIMS

37 CFR § 1.173 (c) requires a discussion of the support in the disclosure for each claim amended of a reissue application.

Claim 38 has been amended to recite: "determining a user-specified degree of parallelism to use in performing the operation." The disclosure describes embodiments that support this feature. Specific support for amended Claim 38 is found at Col. 8, line 57 to Col. 10, line 22. For example, Col. 9, lines 11 - 13 state "the present invention provides the ability for the SQL statement to specify the use and degree of parallelism." Col. 10, lines 15-17 states the "SQL statement can specify the degree of parallelism to be used for the execution of constituent parts of an SQL statement."

It is well known that users formulate the statements that they submit to database servers. Thus, the degree of parallelism specified in a statement submitted by a user is one example of a "user-specified degree of parallelism". (In contrast, the conventional way to determine the degree of parallelism is to have the database server make the determination without any user input).

It should be noted that, while the specific example referred to herein to show support for amended Claim 38 involves a user specifying a desired degree of parallelism in a statement submitted by the user, Claim 38 is not limited to this specific example. Rather, new Claim 92 covers this specific technique "wherein the user-specified degree of parallelism is specified in

-27-

said statement". Thus, the portions of the specification referred to above also provide specific support for new Claim 92.

New Claim 93 recites "wherein the user-specified degree of parallelism is specified for operations that involve a particular table." Support for new Claim 93 is found in Col. 10, lines 15-24, Col. 11, line 62 – Col. 11, line 5, and Col. 13, lines 9-42. For example, Col. 13, lines 33-35 state "if the node represents a table scan DFO, the information includes table scan information such as table name and degree of parallelism identified for the scan."

The amendments to other claims relate to the same features discussed above with respect to Claims 38, 92 and 93. Therefore, they are specifically supported by the same sections of the specification. Further, new claims 94 and 95 are parallel to Claims 92 and 93, and therefore are supported for the same reasons.

Further, it should be noted that support for elements in each claim is generally not limited to a small portion of the specification, but rather the support may be found throughout the explanation of aspects of the invention. Thus, while Applicants have identified specific portions in the specification where support may be found for each claim, additional support for each claim may be found elsewhere in the specification.

SUMMARY OF THE REJECTIONS/OBJECTIONS

The Office Action raises an issue regarding whether claims of Group II of the restriction requirement of April 12, 2002 should be withdrawn from consideration.

Claims 20-52 and 56-88 are rejected under 37 CFR § 1.175(b) as allegedly being based upon a defective reissue declaration.

Claims 27-41, 63-65, and 66-73 are rejected under 35 U.S.C. § 251 as allegedly being broadening in a reissue application.

Claims 42-52 are provisionally rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-19 of co-pending Patent Application No. 10/153,983 (which is a divisional application of the present application).

The Applicants respectfully traverse the rejections/objections.

CLAIMS IN GROUP II HAVE BEEN WITHDRAWN FROM CONSIDERATION

The Office Action of July 17, 2002 (hereinafter "the First Office Action") required the Applicants to elect prosecution of either the claims of Group I (Claims 20-52 and 56-88) or of Group II (53-55 and 89-91). In the Response of May 2, 2002, Applicants elected to pursue claims of Group I without traverse and cancelled the claims of group II (Claims 53-55 and 89-91). The Office Action of July 17, 2002 acknowledged that the claims of Group II stand cancelled. Therefore, those claims are withdrawn from consideration in the present application.

Applicants have filed a divisional application to pursue prosecution the claims of Group II, namely U.S. Patent Application Serial No. 10/153,983. The decision as to whether the claims of Group II should be withdrawn from further consideration has already been made, as these claims stand cancelled in the present application and are being pursued in a divisional application. Consequently, it is respectfully submitted that there are no unresolved issues regarding the claims of Group II.

REISSUE DECLARATION IS VALID UNDER 37 CFR § 1.175

The issue of whether the reissue declaration is valid has already been raised and addressed. The First Office Action raised the issue of whether the reissue declaration is valid under 37 CFR 1.175. The Office Action of January 23, 2003 (hereinafter "the Second Office Action") indicated that the Applicants' Response of October 21, 2002 overcame the issue.

-29-

The present Office Action alleges that the reissue declaration in not valid under 37 CFR §
1.175(b), and that a supplemental reissue oath/declaration is required. With respect to this
allegation, the Office Action states "the nature of the defect is set forth above". However, no
actual defect is ever identified. If there is in fact a defect, the Applicants will gladly execute the
requested supplemental reissue oath/declaration. However, without any defect, a supplemental
reissue oath/declaration is not required.

37 CFR § 1.175(b) states:

> "For any error corrected, <u>which is not covered by the oath or declaration</u>
> <u>submitted under paragraph (a) of this section</u>, application must submit a
> supplemental oath or declaration stating that every such error arose without any
> deceptive intention on the part of the application..."

The reissue declaration identifies the following error that is relied upon to support the reissue
declaration:

> "This is a broadening reissue. The error occurred when, during the prosecution of
> the original patent, the claims were repeatedly amended by inserting into all of the
> independent claims limitations directed to additional novel features regardless of
> the novel features that the claims initially recited. Thus, even the broadest claims
> resulting from this process require a combination of several independently
> patentable features, even though the patentee is entitled to separate claims to each
> of the novel features of the invention. This reissue corrects that error."

Each of the pending claims, including the amendments made herein, is directed towards
correcting the error identified in the reissue declaration.

It is acknowledged by the Second Office Action that the reissue declaration is valid under

37 CFR § 1.175(a). Indeed, the reissue declaration is in full conformance with 37 CFR §

1.175(a) and § 1.63. The reissue declaration covers each error corrected by the reissue

application. Consequently, no further action is required under 37 CFR § 1.175(b), and the

reissue declaration is valid under 37 CFR § 1.175.

ALLEGED RECAPTURE OF CLAIMED SUBJECT MATTER

The issue of whether the present patent application impermissibly broadens the scope of

the claims has already been raised, addressed and resolved. Specifically, the First Office Action

raised the issue of whether the present patent application impermissibly broadens the scope of

the claims. The Second Office Action indicated that the Applicants' Response of October 21,

2002 overcame the issue.

Applicants acknowledge that the claims have been broadened in some respects.

However, the broadening of an aspect of a claim is not the same thing as attempting to recapture

surrendered subject matter. Specifically, applicants are expressly permitted to broaden the scope

of the claims when a reissue patent application is filed within two years of the issue date of the

granted patent. In fact, that is the primary purpose of a broadening reissue application. By

definition, a broadened claim covers more than it previously did. Thus, the mere fact that a

claim covers more than it previously did cannot possibly be prohibited by the recapture

prohibition, or there would not be such a thing as a broadening reissue.

The focus of a recapture inquiry is therefore not on whether a claim has been broadened,

but on whether the claim has been amended in such a way that it has the same scope as subject

matter that was previously surrendered. Thus, the inquiry must begin with a determination of

what specific subject matter, if any, was surrendered during the original prosecution.

-31-

As explained in the Applicants' Response of May 2, 2002, which resulted in the withdrawal of the "recapture" objection, the broadened claims are not directed to any subject matter that was surrendered.

In Mentor Corp. v. Coloplast, Inc. 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993)., the Federal Circuit stated *"the recapture rule prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims."* As shall be explained in further detail below, the recapture rule does not apply to pending Claims 27-52, 63-88, and 92-95 because **no pending claim is to a combination that was admitted to be not patentable in the original application**.

Indeed, the pending claims are directed towards elements and combinations of elements that have not previously been before the Patent and Trade Office for examination. With respect to originally disclosed but unclaimed subject matter, the Federal Circuit recently reiterated that:

> A patentee who inadvertently fails to claim disclosed subject matter, however, is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter. 35 U.S.C. § 251 (2000).

Johnson & Johnston Associates, Inc. v. R.E. Service Co., 62 USPQ2d 1225, 1231 (CA FC 2002).

The claims of a broadening reissue patent may be broader than the issued patent it is based upon, as long as the claims in the broadening reissue application do not contain surrendered subject matter. *"A party may broaden its patent while applying for a reissue claim. The law does not, however, permit attempts to recapture subject matter affirmatively surrendered during the initial patent prosecution, particularly where the purpose of surrender*

-32-

was to distinguish the claimed invention from the prior art." B.E. Meyers & Co. v. United States, 47 Fed. Cl. 200, 206, 56 USPQ2d 1110, 1115. "*To determine whether an applicant surrendered particular subject matter, we look at the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.*" In Re Clement, 142 F.3d at 1480, 46 USPQ2d at 1648.

The patent application that resulted in U.S. Patent no. 5,857,180 consisted of two communicative papers from the Applicants after the application was filed; specifically, a preliminary amendment mailed on July 21, 1997, and an amendment mailed on January 26, 1998. Accordingly, to the extent the recapture doctrine applies, only the preliminary amendment ("the July preliminary amendment") mailed on July 21, 1997 and the amendment ("the January amendment") mailed on January 26, 1998 need to be considered. Thus, in the present broadening reissue, the claims in the reissue application may be broader than the scope of the claims in the original patent, as long as the claims in reissue application contain no subject matter surrendered in the July preliminary amendment or the January amendment.

What Was Surrendered In The Original Application

The July preliminary amendment amended the independent claims, as they existed at that time, to include in the specific arrangement of elements: (a) slave processes (or producer slaves) operate on a plurality of data partitions, and (b) the quantity of data partitions is greater than the quantity of said slave processes (or producer slaves). These features are referred to hereafter as the ("preliminary amendment features"). Thus, to the extent that any admission was made in the July preliminary amendment, the only possible admission is that the specific combination that was recited in the amended claims, prior to the amendment, would not have been novel by itself.

-33-

Any theory that would find a broader admission, an admission relating to combinations other than those that were in the amended claims, would be flawed. For example, it would be preposterous to conclude that an amendment that adds a limitation to a specific combination is an admission that **all** subject matter disclosed in an application, whether or not presently in any claim, could not be allowable without the limitation.

The fact that the claims amended in the preliminary amendment were only directed to one aspect of the invention was emphasized in the July preliminary amendment. With that amendment, the Applicant specifically pointed out that "amended Claim 1 of the present application recites a parallelized execution plan including first and second operations, wherein the second operation includes one or more slave processes operating on a plurality of data partitions, the quantity of the data partitions being greater than the quantity of the slave process, each of the slave processes operating on a different one of the data partitions...As set forth above, **this aspect** of the present invention is not taught or suggested by Hong alone or in combination with any of the other cited references (emphasis added)."

The Applicants never stated nor implied that the preliminary amendment features where the only features disclosed in the entire application upon which a finding of novelty could be based. Rather, the Applicants merely pointed out that the specific combination originally recited in the claims, when combined with the preliminary amendment features, produced one novel combination of elements (from a specification that disclosed many such combinations). In other words, the July preliminary amendment was silent as to other aspects of the invention, e.g., subject matter currently not embodied in a claim being examined. Further, the Applicants never argued that the invention was limited to aspects that comprised the preliminary amendment features. **Thus, to the extent that there was a surrender of subject matter in the July**

-34-

preliminary amendment, the admission was that the specific combination of elements of the amended independent claims, in the state they were in prior to the amendment, required the preliminary amendment features for patentability.

The January amendment amended the independent claims, as they existed at that time, to include the feature that at least one slave process operates on more than one of said data partitions (hereinafter, the "January feature"). The January feature was added in response to a rejection under 35 U.S.C. § 112, second paragraph as being indefinite for allegedly not making it clear how a quantity of data partitions greater than a quantity of slave processes could eventually allow each slave process to operate on a different partition. Granted, this feature was referred to as "key" in that it further distinguished the claims to which it was added over the Hong reference. However, **to the extent that this statement constitutes an admission, it admits nothing more than: at least one slave process must operate on more than one data partition when the quantity of data partitions is greater than the quantity of slave processes that operate on them.**

Applicants submit that not every aspect of the invention involves slave processes, the quantity of slave processes, or how many partitions each slave process works on. Further, in some aspects of the invention that involve slave processes, the reference in the claims may not provoke confusion as to how a quantity of data partitions greater than a quantity of slave processes could eventually allow each slave process to operate on a different partition given the context of the reference of slave processes in the claim.

The Applicants submit that the claims of the present reissue patent application are directed towards combinations of elements that were never before the Patent and Trademark Office for examination previously. Consequently, the right to claim these specific combinations

-35-

could not have been surrendered. Rather, the subject matter of the current claims was never in a position to be surrendered, as that subject matter, in the particular combinations in which it is now claimed, was never examined by the Patent and Trademark Office.

Reasons Why the Pending Claims do not attempt to Recapture Surrendered Subject Matter

Pending Claims 27-52, 63-88, and 92-95 do not attempt to recapture surrendered subject matter because the claims are not directed to any combination of elements to which the right to claim was previously surrendered.

Each of the pending claims contains a limitation that does not correspond to any element that was present in the combination of elements recited in the claims of the parent during prosecution. Therefore, it is impossible for the present claims to recapture surrendered subject matter. The logic is this: if a claim is to a combination that includes X, and the original claims were to combinations that did not have X, then any admission that the original claims were not patentable could not possibly be interpreted as an admission that a combination that includes X is not patentable. Said differently, the "surrender" of a combination that does not include X cannot possibly be interpreted as the surrender of a combination that does include X. The absence of any surrendered subject matter in Claims 27-52, 63-88, and 92-95 shall be discussed in detail below.

A.   Claims 27-37 and 63-73

Claims 27-37 and 63-73 recite the following limitations:

"dividing the operation into a set of work partitions;

-36-

assigning work partitions from said set of work partitions to a plurality of entities,

wherein at least one entity of said plurality of entities is assigned a plurality of

work partitions from said set of work partitions;

said plurality of entities operating in parallel on work partitions assigned to them to

perform said operation;"

The above-quoted elements were not previously presented for prosecution in the parent

application. Therefore, the combination of elements presented in Claims 27-37 and 63-73 was

not previously submitted for examination; thus, Claims 27-37 and 63-73 could not possibly

recapture surrendered subject matter.

In addition, there are additional reasons why each of Claims 27-37 and 63-73 does not

recapture surrendered subject matter. For example, independent Claims 27 and 63 and

dependent Claims 28 and 64 recite the limitation of: "wherein the step of assigning work

partitions is performed by assigning the work partitions in a sequence based at least in part on

sizes associated with the work partitions." This limitation does not correspond to any element

that was present in the combination of elements recited in any claim of the parent application

during prosecution. Therefore, it is respectfully submitted that Claims 27, 28, 63 and 64 do not

recapture any surrendered subject.

Independent Claims 29 and 65 recite the limitations of:

"after said at least one entity has completed operation on said first work partition,

assigning said at least one entity a second work partition from said set of work

partitions, wherein the step of assigning said at least one entity a second work

partition includes

-37-

determining whether there are any unassigned work partitions from a first level in

the hierarchy to which said first work partition belonged; and

if there are no unassigned work partitions from the first level in the

hierarchy, then selecting said second work partition from a level in

said hierarchy that is two levels above said first level in said

hierarchy;"

These limitations do not correspond to any element or elements that were present in the

combination of elements recited in any claims of the parent application during prosecution.

Therefore, it is respectfully submitted that Claims 29 and 65 do not recapture any surrendered

subject matter.

Independent Claims 30 and 66 and dependent Claims 31-32 and 67-68 recite the

following limitation: "the step of dividing an operation is performed by dividing said second

operation." This limitation does not correspond to any element that was present in the

combination of elements recited in any claim of the parent application during prosecution.

Therefore, it is respectfully submitted that Claims 30-32 and 66-68 do not recapture any

surrendered subject matter.

B.   Claims 38-41, 74-77, and 92-95

Independent Claims 38 and 74 feature the limitations of:

"receiving a statement that specifies at least an operation;

determining a user-specified degree of parallelism to use in performing the operation;

performing a determination of how many entities to use to perform said operation based,

at least in part, on the user-specified degree of parallelism;"

-38-

The above-quoted elements were not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 38 and 74 were not previously submitted for examination; thus, Claims 38 and 74 could not possibly recapture surrendered subject matter.

Each of dependent Claims 39-41, 75-77, and 92-95 depend from either independent Claims 38 or 74; thus, each dependent claim contains the limitations discussed above with respect to Claims 38 and 74. As a result, it is respectfully submitted that each of dependent Claims 39-41, 75-77, and 92-95 do not contain any surrendered subject matter for the reasons discussed above with respect to Claims 38 and 74.

Additionally, dependent Claims 39-41, 75-77, and 92-95 do not recapture surrendered subject matter for additional reasons than those discussed above with reference to Claims 38 and 74. For example, Claims 39 and 75 feature the limitations of:

"the query requires a plurality of operations;

the user-specified degree of parallelism is specified is said statement, and

the statement specifies said degree of parallelism for a subset of the plurality of

operations required by the query."

The above-quoted elements were not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 39 and 75 were not previously submitted for examination; thus, Claims 39 and 75 could not possibly recapture surrendered subject matter.

Claims 40 and 76 feature the limitation of: "wherein the user-specified degree of parallelism is specified in said statement; and the degree of parallelism specified by the query indicates that no amount of parallelism is to be used during execution of a particular portion of

-39-

the query." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 40 and 76 were not previously submitted for examination; thus, Claims 40 and 76 could not possibly recapture surrendered subject matter.

Claims 41 and 77 feature the limitation of: "wherein the user-specified degree of parallelism is specified in said statement, and the degree of parallelism specified by the query indicates a maximum amount of parallelism to use during execution of said operation." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 41 and 77 were not previously submitted for examination; thus, Claims 41 and 77 could not possibly recapture surrendered subject matter.

Claims 92 and 94 feature the limitation of: "wherein said degree of parallelism is specified by a user." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 92 and 94 were not previously submitted for examination; thus, Claims 92 and 94 could not possibly recapture surrendered subject matter.

Claims 93 and 95 feature the limitation of: "wherein: the query requires a plurality of operations; and said statement specifies said degree of parallelism for a particular table associated with a particular operation in said plurality of operations." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 93 and 95 were not previously submitted for examination; thus, Claims 93 and 95 could not possibly recapture surrendered subject matter.

C. Claims 42-48 and 78-84

Independent Claims 42 and 78 feature the limitations of:

"incorporating hints into at least some of said query fragments, wherein the hint

associated with a given query fragment indicates how to perform the work

partition associated with said given query fragment."

The above-quoted element was not previously presented for prosecution in the parent

application. Therefore, the combination of elements claimed by Claims 42 and 78 were not

previously submitted for examination; thus, Claims 42 and 78 could not possibly recapture

surrendered subject matter.

Each of dependent Claims 43-48 and 79-84 depend from either independent Claims 42 or

78; thus, each contains the limitations discussed above with respect to Claims 42 and 78. As a

result, it is respectfully submitted that each of dependent Claims 43-48 and 79-84 does not

recapture any surrendered subject matter for the reasons discussed above with respect to Claims

42 and 78.

Additionally, dependent Claims 43-48 and 79-84 do not recapture surrendered subject

matter for additional reasons than those discussed above with reference to Claims 42 and 78. For

example, Claims 43 and 79 feature the limitation of: "wherein the step of incorporating hints

includes incorporating hints that dictate the operation of a table scan." The above-quoted

element was not previously presented for prosecution in the parent application. Therefore, the

combination of elements claimed by Claims 43 and 79 were not previously submitted for

examination; thus, Claims 43 and 79 could not possibly recapture surrendered subject matter.

Claims 44 and 80 feature the limitation of: "wherein the step of incorporating hints

dictate the operation of a table scan includes incorporating hints that rowed partitioning is to be

-41-

used during the table scan." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 44 and 80 were not previously submitted for examination; thus, Claims 44 and 80 could not possibly recapture surrendered subject matter.

Claims 45 and 81 feature the limitation of: "wherein the step of incorporating hints includes incorporating hints that specify performance of a full table scan." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 45 and 81 were not previously submitted for examination; thus, Claims 45 and 81 could not possibly recapture surrendered subject matter.

Claims 46 and 82 feature the limitation of: "wherein the step of incorporating hints includes incorporating hints that specify using a particular type of join." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 46 and 82 were not previously submitted for examination; thus, Claims 46 and 82 could not possibly recapture surrendered subject matter.

Claims 47 and 83 feature the limitation of: "wherein the step of incorporating hints that specify using a particular type of join includes incorporating hints that specify using a sort/merge join." The above-quoted element was not previously presented for prosecution in the parent application. Therefore, the combination of elements claimed by Claims 47 and 83 were not previously submitted for examination; thus, Claims 47 and 83 could not possibly recapture surrendered subject matter.

Claims 48 and 84 feature the limitation of: "wherein the step of incorporating hints that specify using a particular type of join includes incorporating hints that specify using a nested loop join." The above-quoted element was not previously presented for prosecution in the parent

-42-

application. Therefore, the combination of elements claimed by Claims 48 and 84 were not previously submitted for examination; thus, Claims 48 and 84 could not possibly recapture surrendered subject matter.

D.   Claims 49-52 and 85-88

Independent Claims 49 and 85 feature the limitations of:

"determining a hierarchy of operations associated with a query;

dividing a first operation required by said query into a first set of work partitions;

dividing a second operation required by said query into a second set of work partitions, wherein said second operation immediately follows said first operation in said hierarchy;

dividing a third operation required by said query into a third set of work partitions, wherein said third operation immediately follows said second operation in said hierarchy;

assigning work partitions from said first set of work partitions to a first plurality of entities;

said first plurality of entities operating in parallel on work partitions assigned to them from said first set of work partitions to perform said first operation;

assigning work partitions from said second set of work partitions to a second plurality of entities, wherein said second plurality of entities are different entities than said first plurality of entities; and

said second plurality of entities operating in parallel on work partitions assigned to them from said second set of work partitions to perform said second operation;

Docket No. 50277-1646
OID 1993-06-CON2-R

assigning work partitions from said third set of work partitions to said first plurality of

entities; and

said first plurality of entities operating in parallel on work partitions assigned to them

from said third set of work partitions to perform said third operation."

The above-quoted elements were not previously presented for prosecution in the parent

application. Therefore, the combination of elements claimed by Claims 49 and 85 were not

previously submitted for examination; thus, Claims 49 and 85 could not possibly recapture

surrendered subject matter.

Each of dependent Claims 50-52 and 86-88 depend from either independent Claims 49 or

85; thus, each contains the limitations discussed above with respect to Claims 49 and 85. As a

result, it is respectfully submitted that each of dependent Claims 50-52 and 86-88 does not

recapture any surrendered subject matter for the reasons discussed above with respect to Claims

49 and 85.

Additionally, dependent Claims 50-52 and 86-88 do not recapture surrendered subject

matter for additional reasons than those discussed above with reference to Claims 49 and 85. For

example, Claims 50 and 86 feature the limitations of:

"determining whether there are any unassigned work partitions from said first set of work

partitions; and

if there are no unassigned work partitions from said first set of work partitions, then

assigning the given entity a work partition selected from said third set of work

partitions; and

-44-

if there are unassigned work partitions from said first set of work partitions, then

assigning the given entity a work partition selected from said first set of work

partitions."

The above-quoted elements were not previously presented for prosecution in the parent

application. Therefore, the combination of elements claimed by Claims 50 and 86 were not

previously submitted for examination; thus, Claims 50 and 86 could not possibly recapture

surrendered subject matter.

Claims 51 and 87 feature the limitation of: "wherein the hierarchy includes odd levels

and even levels, and the method further comprises the steps of assigning work partitions from

odd levels to said first plurality of entities and work partitions from even levels to said second

plurality of entities." The above-quoted element was not previously presented for prosecution in

the parent application. Therefore, the combination of elements claimed by Claims 51 and 87

were not previously submitted for examination; thus, Claims 51 and 87 could not possibly

recapture surrendered subject matter.

Claims 52 and 88 feature the limitation of: "wherein performing work partitions in said

first set of work partitions causes said first set of entities produce output consumed by said

second plurality of entities, and performing work partitions in said third set of work partitions

causes said first set of entities to consume output produced by said second plurality of entities."

The above-quoted element was not previously presented for prosecution in the parent

application. Therefore, the combination of elements claimed by Claims 52 and 88 were not

previously submitted for examination; thus, Claims 52 and 88 could not possibly recapture

surrendered subject matter.

RESPONSE TO DOUBLE PATENTING REJECTION

Claims 42-52 are provisionally rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-19 of co-pending Patent Application No. 10/153,983 (which is a divisional application of the present application).

The First Office Action required the Applicants to elect prosecution of either the claims of Group I (Claims 20-52 and 56-88) or of Group II (53-55 and 89-91). By issuing the restriction requirement, the United States Patent and Trademark Office indicated that it determined that there was more than one independent and distinct invention claimed in the reissue application. In response, the Applicants elected to prosecute the claims of Group I in the present application, and filed a divisional Patent Application No. 10/153,983 to pursue the claims of Group II.

"A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on <u>an application filed as a result of such a requirement,</u> <u>shall not be used as a reference</u> either in the Patent and Trademark Office or in the courts against a divisional application or <u>against the original application</u> or any patent issued on either of them, <u>if the divisional application is filed before the issuance of the patent on the other application.</u>" 35 U.S.C. 121 (emphasis added). As divisional Patent Application No. 10/153,983 was (a) filed in response to a restriction requirement on the present patent application, and (b) filed before the issuance of the present patent application, divisional Patent Application No. 10/153,983 may not be used as a reference against the present patent application.

Consequently, it is respectfully requested that rejection of Claims 42-52 under the judicially created doctrine of double patenting over divisional Patent Application No. 10/153,983 be withdrawn.

-46-

Docket No. 50277-1646
OID 1993-06-CON2-R

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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Dated: September 30, 2004

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Docket No. 50277-1646
OID 1993-06-CON2-R